

U.S. Patent Appln. No. 10/086,391  
Amendment Dated December 12, 2003  
Reply to Office Action of August 12, 2003  
Docket No. BOC9-2001-0012 (247)

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### REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of August 12, 2003 (Office Action). This response is being filed with a petition for a one month retro-active extension of time with the appropriate fee.

In paragraph 1 of the Office Action, claims 12, 15, and 21 have been objected to because of minor informalities. In response, the Applicants have amended claims 12, 15, and 21 so that the phrase "selected form" now properly reads "selected from". Additionally, the Applicants have removed the term "password" from each of claims 12, 15, and 21.

In paragraphs 2 and 3, claims 1-17 and 19-24 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,026,156 to Epler, *et al.* (Epler). Further, in paragraphs 4 and 5, claims 18 and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Epler in view of U.S. Publication No. 2002-0146107 to Baals, *et al.* (Baals).

In response to the 35 U.S.C. § 103(a) rejection, the Applicants have enclosed affidavits under 37 C.F.R. § 1.131 supporting the removal of Baals as a reference. The affidavits are accompanied by a copy of the Applicants' confidential invention disclosure entitled "Fancy Caller ID Tones". The confidential invention disclosure and affidavits demonstrate proof of conception for the claimed subject matter of the Applicants' invention at least as early as February 12, 2001, which predates the effective date of Baals. The Applicants further exercised due diligence from prior to the effective date of Baals until March 1, 2002, the filing date of the instant application. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection with respect to claims 18 and 25 is respectfully requested.

① Claims 1-17 and 19-24 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Epler. Epler discloses a method and system for providing enhanced call waiting telephony functions. In particular, Epler discloses a system where an interrupting party to an established telephone call can be prompted with a courtesy message asking the interrupting party to select one of a plurality of available options for

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handling the call. Significantly, Epler relies upon the use of a Distinctive Ringing feature which allows a subscriber to associate more than one number with a particular telephone line. Distinctive Ringing allows a distinctive ring to be played when an incoming call arrives on a given telephone line. The type of ring that is triggered is dependent upon which number associated with the line is called.

The Epler invention relies upon Distinctive Ringing to implement the enhanced call waiting described therein. In contrast to the teachings of Epler, the present invention does not utilize a Distinctive Ringing feature to provide varied call waiting tones. As such, Epler does not disclose the Applicants' invention as claimed.

With respect to claims 3, 12, 15, and 21 the Examiner contends that Epler teaches that the call information provided by the user identifies the call as being out-of-area with respect to the participant. In support, the Examiner has cited column 14, line 61 – column 15, line 4. While the cited passage does teach that subscribers can set up several categories of callers, Epler does not teach any specific categories. In particular, Epler does not teach that the calling number can be evaluated to determine whether the area code of the calling number is the same as the area code of the called number.

Claims 12, 15, and 21 also state that the call information can specify information such as the time of day at the point of origin (location of the calling party), a geographic location, and a time zone indication. As noted above, Epler fails to teach any such specific classifications or functions.

With respect to claims 17 and 24, the Examiner contends that Epler teaches that the selections can be made via a telephone connection. In support, the Examiner has cited Fig. 3 and column 13, line 65 – column 14, line 20. This passage suggests that the interrupting caller can provide selections over a telephone connection. Claims 17 and 24, however, are directed to the subscriber configuring the various call characteristics that are compared to determine which call waiting tone is to be played. That is, the subscriber can call into the system and to specify the particular call characteristics to be used when the system operates. As such, the cited passage does not teach the limitations of claims 17 and 24.


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The Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: 12/12/03

  
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